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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,298	10/07/2003	Tetsuya Kanemaru	053466-0372	3585

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EXAMINER

BARHAM, BETHANY P

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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05/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/679,298

Applicant(s)

KANEMARU ET AL.

Examiner

Bethany P. Barham

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent-Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/09/2007, 08/10/2006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Summary

Receipt of Applicant's 132 Declaration filed on 03/06/2007 is acknowledged.
Receipt of Applicant's Arguments and Claims filed on 03/06/2007 is also acknowledged.
Claims 6-8 and 10-11 are pending. Claims 6-8 and 10-11 are rejected.

Applicants submitted a 132 declaration on 03/09/2007, the declaration was not found persuasive. Applicant has submitted a 132 declaration to show that the heat treating must take place especially at 400-600°C, in order for the Si-H peaks to be absent from the IR and so that undesirable hydrogen generation does not occur, this is not commensurate with the scope of the claims as written, which teach a range of '260-500°C, furthermore the instant specification teaches away from temperatures at and above 500°C (pg. 2, lines 2-3), which is contradicted by applicants own 132 declaration, which teaches that temperatures 'especially 400-600°C' are preferable. Applicant's declaration was not found persuasive and the rejections of record are hereby **maintained**.

NEW AND MAINTAINED REJECTIONS

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New:

Claims 6 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a heating range of 260 to 480°C for 0.1 to 24 hours (pg. 3, line 28, pg. 4, lines 21-22 and pg. 8, line 5), it is not enabled for 260 to 500°C. Claim 6 has the limitation for 260 to 500°C and this limitation is not found in the instant specification, which instead teaches away from temperatures at and above 500°C (pg. 2, lines 2-3).

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 8 is not currently supported by the specification which teaches heat treating with a temperature of 330 to 480°C yields a particle size 'more than' 0.1 micron or 'not less than' 0.1 micron (pg. 8, lines 20-23 and pg 9, lines 17-19). Example 1-1 teaches an average particle size of 4 microns when heated 400°C for 3 hours. Claim 8 as amended has added new matter.

Maintained:

Claims 7-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of producing silicone treated powder

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wherein said powders have an average particle size of not more than 0.1 microns when heated in the second step at a temperature of 270°C for 3 hours and said powders have an average particle size of less than 0.1 microns when heated in the second step at a temperature of 400°C for 3 hours, does not reasonably provide enablement for the a method of producing silicone treated powders wherein said powders have an average particle size of not more than 0.1 microns when heated in the second step at a temperature of 260°C - 350°C for 1-5 hours and said powders have an average particle size of less than 0.1 microns when heated in the second step at a temperature of 330°C - 480°C for 1-5 hours. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. After carefully evaluating the instant specification, the examiner respectfully asserts that one of ordinary skill in the art would be forced to undergo undue experimentation in order to practice the invention commensurate in scope with these claims. Specifically, as set forth in the instant specification, coated powders have an average particle size of not more than 0.1 microns when heated in the second step at a temperature of 270°C for 3 hours or the coated powder can have an average particle size of less than 0.1 microns when heated in the second step at a temperature of 400°C for 3 hours (pages 9 - 17 in the instant specification). After carefully reviewing the instant specification, there is no data indicating that coated powders can have an average particle size of not more than 0.1 microns when heated in the second step at a temperature of 260°C - 350°C for 1-5 hours or that powders can have an average particle size of less than 0.1 microns when

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heated in the second step at a temperature of 330°C - 480°C for 1-5 hours. Moreover, the examiner respectfully points out that the temperature ranges of claims 7-8 overlap. That is, as set forth in the instant claims 7-8, at a temperature of 330°C - 350°C for 1-5 hours, the powder can seemingly have an average particle size of not more than 0.1 microns as well as an average particle size of not less than 0.1 microns. The examiner respectfully submits that this inconsistency is further evidence that one of ordinary skill in the art would be forced to undergo undue experimentation in order to practice the invention commensurate in scope with these claims.

Furthermore, Example 4 teaches a time of 10 minutes for the heat treatment of 270°C, this is also not commensurate with the scope of the claims as written.

Response to Arguments

Applicant's arguments and amendments with respect to claims 7-8 have been considered but are not persuasive. Claims 7-8 are specifically stating that the temperature at which the powder is 'heat' treated, determines the particle size of the material. Applicant cannot (according to the instant specification) treat the powder at the same heat (between 330-350°C) in order to get 2 different sizes, one more than 0.1 micron and one less than 0.1 micron. Instead the specification Example 3-1 specifically, points out that heating at 270°C gives an average particle size of 0.015 microns (not more than 0.1 micron), while Example 1-1 heats at 400°C with an average particle size of 4 microns (not less than 0.1 micron). The examiner respectfully submits that claims

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7-8 as written are not enabled to have the same 'heat' treatment and yield two divergent particle sizes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-092484 ('484).

The limitations of claims 6 and 10-11 are taught by '484:

- '484 disclose a method of coating a nanoparticle or powder with various silicon-based materials (paragraphs 0026 - 0164). According to '484, the silicon precursors used to coat the powder contain at least one Si-H group and are represented by the following structural formula



- Like the instant claim set, "c" can be 2 and "a" and "b" are within the ranges as set forth in the instant claim 6. According to '484, the powder substance can be coated with a silicone-based material at a temperature up to 300°C for 1 hour or more (paragraph 0046). The examiner respectfully submits that this meets the

limitations of the instant claim 6. Like the instant claim set, the reaction may take place in the gaseous phase (paragraph 0046).

- The claims are therefore anticipated by JP 08-092484 ('484).

Response to Arguments

Applicant's arguments with respect to claims 6-8 and 10-11 have been considered but are not persuasive. Applicant argues that treating the silicone material is not the same as taught by '484, but as shown above the formula is the same. Furthermore, a heat treatment of the silicone material is taught by '484 to a range of up to 300°C anticipates the instant claims (heat treatment of 260-500°C for 0.1-24 hours), but the claims as written overlap with the prior art, and as such are anticipated. Heat treating silicone materials of the instant claims is known in the prior art in the overlapping with the temperature and time ranges of applicant and applicant's 132 declaration is not persuasive for the reasons above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-26871 ('871) in view of US 2002/014094 ('094).

The limitations of claim 6, and 10-11 are taught:

- '871 teach a method of coating a nanoparticle or powder with various silicon-based materials (paragraphs 0018 - 0051). The nanoparticles may be metal, organic pigment, or inorganic pigment (paragraphs 0027 -0028). According to '871, the silicon precursors used to coat the powder contain at least one Si-H group and are represented by the following structural formula Claim 4 and paragraph 0018):



- Like the instant claim set, "c" can be 2 and "a" and "b" are within the ranges as set forth in the instant claim 6. According to '871, the powder substance can be coated with a silicone-based material at a temperature of about 400°C (paragraph 0046).
- Although '871 teach that the powder may be heated to a temperature of about 400°C, '871 is silent with respect to the amount of time said powder should be heated.
- However, '094 teaches the advantages of heating the powder-particles at a temperature between 200°C - 500°C for a time period between 30 minutes to 4 hours. Like the instant claim Set, said particles may be heat treated in an

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atmosphere of inert gas (paragraph 0101). As taught by '094, heating the powder-particles at a temperature of 200°C - 500°C for a time period between 30 minutes to 4 hours has the benefit of increasing the heat resistance, adhesion, and insulation of said particles (paragraph 0101). Because, as set forth in '094, heating the powder-particles at a temperature of 200°C - 500°C for a time period between 30 minutes to 4 hours has the benefit of increasing the heat resistance, adhesion, and insulation of said particles, one of ordinary skill in the art would have been motivated heat the particles advanced by '871 to a temperature of 200°C - 500°C for a time period between 30 minutes to 4 hours. Again, according to '871, the powder substance can be coated with a silicone-based material at a temperature of about 400°C. The examiner respectfully submits that '094 provide the requisite motivation to heat said particles for a time period between 30 minutes to 4 hours. Based on the teachings of '094, there is a reasonable expectation that heating the powder-particles at a temperature of 200°C - 500°C for a time period between 30 minutes to 4 hours would effectively modulate the heat resistance, adhesion, and insulation of said particles. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to heat the particles advanced by '871 to a temperature of 200°C - 500°C for a time period between 30 minutes to 4 hours in view of teachings of '084.

Response to Arguments

Applicant's arguments with respect to claims 6-8 and 10-11 have been considered but are not persuasive. Applicant argues that treating the silicone material with heat of a range of up to 400°C as taught by '271 in view of '094 (which teaches 200-500°C for 0.5 to 4 hours) does not render obvious the instant claims (heat treatment of 260-500°C for 0.1-24 hours), but the claims as written overlap with the prior art, and are therefore obvious. Heat treating silicone materials of the instant claims is known in the prior art in the overlapping with the temperature and time ranges of applicant and applicant's 132 declaration is not persuasive for the reasons above.

Conclusions

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

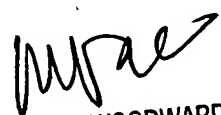
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bethany Barham whose telephone number is (571)-272-6175. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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